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## PRE-APPEAL BRIEF REQUEST FOR REVIEW

FPP-1035-641



	Application Number	Filed
	10/581,603	June 5, 2006
First Named Inventor		WADA
Art Unit	3761	Examiner
		C.L. Anderson

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the  
 Applicant/Inventor

Assignee of record of the entire interest. See 37 C.F.R. § 3.71. Statement under 37 C.F.R. § 3.73(b) is enclosed. (Form PTO/SB/96)

Attorney or agent of record 19,828  
 (Reg. No.)

Attorney or agent acting under 37CFR 1.34.  
 Registration number if acting under 37 C.F.R. § 1.34 \_\_\_\_\_

Signature

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 Requester's telephone number

May 21, 2010  
 Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.\*

\*Total of 1 form/s are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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### STATEMENT OF ARGUMENTS FOR PRE-APPEAL REVIEW

The following description of clear errors is responsive to the Final Rejection mailed on January 29, 2010.

#### The Final Rejection fails to establish that claims 1-9 are “obvious” under 35 U.S.C. §103(a) over Sun et al. (“Sun”) (6514615) in view of Beihoffer et al. (“Beihoffer”) (6222091).

In order to establish a *prima facie* case of obviousness, all of the claim limitations must be taught or suggested by the prior art. It is submitted that the combined teachings of Sun and Beihoffer fail to teach or suggest the water-absorbing agent recited in Claims 1-9 and including the following properties:

- (1) heat retention indicator 1 (maximum temperature decrease per minute 5 to 10 minutes after 10 times swelling in a 0.90 wt. % sodium chloride at 50°C) is from 0 to 3.0°C/min;
- (2) a centrifuge retention capacity in a 0.90 wt. % aqueous solution of sodium chloride (30 minute value) is 34 g/g or less;
- (3) an absorbency in a 0.90 wt. % aqueous solution of sodium chloride against a pressure of 2.0 kPa (60 minute value) is less than 30 g/g; and
- (4) a saline flow conductivity (SFC) for a 0.69 wt. % aqueous solution of sodium chloride is less than  $20 \times 10^{-7} \text{ cm}^3 \text{ sec/g}$ .

As stated on pages 4-7 of the specification, the inventors have found that a drop in the temperature of the absorbent after a diaper or the like absorbent absorbs excreted urine or other body fluids, i.e., the “cool feel” of the wearer, is a factor that seriously affects comfort. In the manufacture and/or construction of such absorbents, heat retention has not been considered and thus none of them have achieved a satisfactory level of heat retention and actual use. Accordingly, it is important to provide high heat retention and also attain a required level of absorption performance.

The inventors have found that the heat retention of a diaper or the like can be enhanced by improving a particular capability of the water-absorbing resin, which has led to the present invention. This particular capability is measured by a "heat retention indicator I" of the water-absorbing resin which is an absolutely novel parameter for a water-absorbing resin to be used in a water-absorbing agent. The heat retention indicator I is a representation of a temperature change on the surface of the water-absorbing resin over a unit time after a liquid is poured onto the water-absorbing resin. The lower the heat retention indicator I, the smaller the temperature change on the water-absorbing resin surface and the better the heat retention. Accordingly, the inventors have found that a water-absorbing resin with a satisfactory heat retention indicator I can be prepared by controlling the centrifuge retention capacity, absorbency under pressure and saline flow conductivity during manufacture. This novel combination of properties, as set forth in Claim 1 and dependent Claims 2-9 is not disclosed or even suggested by the teachings of the cited references, taken individually or in combination. The cited references fail to teach a water-absorbing agent which exhibits excellent performance without an uncomfortable feeling when used as a diaper or the like, owing to the combination of the four properties set forth in the claims, namely, a heat retention indicator, a centrifuge retention capacity, an absorbency, and a saline flow conductivity.

The Examiner acknowledges that Sun fails to teach the saline flow conductivity and the heat retention indicator called for in all of the claims. Although Sun is silent as to the heat retention indicator of the water-absorbing agent, the Examiner takes the position that, since Sun discloses an identical water-absorbing agent, the water-absorbing agent of Sun will inherently exhibit the claimed heat retention indicator.

The Examiner then combines the teachings of the secondary reference to Beihoffer which discloses a saline flow conductivity, with the teachings of Sun in an attempt to render obvious the novel combination of elements in Claims 1-9. It is noted, however, that neither

Sun nor Beihoffer recognizes the importance of a heat retention indicator in combination with a required level of absorption performance in a water-absorbing agent. There is no basis, therefore, for combining the teachings of Beihoffer with Sun in an attempt to render obvious the novel recitations in Claims 1-9, particularly, the combination of the four properties in Claim 1, namely, heat retention indicator, centrifuge retention capacity, absorbency and saline flow conductivity. The importance of the combination of these elements is not recognized in Sun or Beihoffer taken alone or in combination.

In the Final Office Action, the Examiner states that Applicants' arguments fail to explain why the heat retention indicator 1 is not inherent to the resin and do not explain what factors result in the heat retention indicator 1 and why the resin disclosed by Sun would not exhibit the claimed heat retention indicator. It is noted that the Examiner, not the Applicants, has the burden of establishing a *prima facie* case of obviousness. In the present application, Applicants have clearly described and claimed the novel combination of elements in the new and improved water-absorbing agent and the fact that a water-absorbing resin with a satisfactory heat retention indicator 1 can be prepared by controlling the centrifuge retention capacity, absorbency under pressure and saline flow conductivity during manufacture. It is obvious that the Examiner has clearly failed to establish why on a *prima facie* basis the novel combination of elements in Claims 1-9 would be obvious in view of the combined teachings of Sun and Beihoffer. If the Examiner does not establish a *prima facie* case of obviousness, it is not the burden of the Applicants to establish non-obviousness.

In paragraph 7 of the Final Office Action, the Examiner states that the temperature change on the surface of the water-absorbing resin is inherent to the water-absorbing resin, with the result that the water-absorbing agent of Sun will inherently exhibit the claimed heat retention indicators. This abstract statement clearly fails to establish why the novel combination of elements in Claims 1-9 would be obvious in view of the combined teachings of Sun and Beihoffer. There is no disclosure or suggestion in either of these references that a

water-absorbing resin with a satisfactory heat retention indicator can be prepared by controlling the centrifuge retention capacity, absorbency under pressure and saline flow conductivity, as recited in all of the claims.

Applicants, therefore, respectfully request that the Pre-Appeal Panel find that Claims 1-9 in their present form are allowable over the Sun and Beihoffer references cited by the Examiner in the Final Office Action.

Respectfully submitted,

**NIXON & VANDERHYE P.C.**

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